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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/662,183

09/12/2003

Serge Auvin

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EXAMINER

MURRAY, JEFFREY H

ART UNIT

PAPER NUMBER

1609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

03/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/662,183

Applicant(s)

AUVIN ET AL.

Examiner

Jeffrey H. Murray

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09,787,467.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. The compound or composition of the formula (I') according to Claims 14-25, wherein A is a substituted phenyl, classified in class 564, and various subclasses depending on the nature of the substituents.
 - II. The compound or composition of the formula (I') according to Claims 14-17, 19, 21-25, wherein A has a five-membered heterocyclic ring with at least one nitrogen, classified in class 548, and various subclasses depending on the nature of the substituents.
 - III. The compound or composition of the formula (I') according to Claims 14-17, 19, 21-25, wherein A has a six-membered heterocyclic ring with only one heteroatom, a nitrogen, classified in class 546, and various subclasses depending on the nature of the substituents.
 - IV. The compound or composition of the formula (I') according to Claims 14-17, 19, 21-25, wherein A has a six-membered heterocyclic ring with at least two heteroatoms, at least one being nitrogen, classified in class 544, and various subclasses depending on the nature of the substituents.
 - V. The compound or composition of the formula (I') according to Claims 14-17, 19, 21-25, wherein A has a four-membered heterocyclic ring with one nitrogen,

classified in class 548, and various subclasses depending on the nature of the substituents.

VI. The compound or composition of the formula (I') according to Claims 14-17, 19, 21-25, wherein A has a seven-membered or larger nitrogen containing heterocyclic ring, classified in class 540, and various subclasses depending on the nature of the substituents.

VII. The compound or composition of the formula (I') according to Claims 14-25, not previously described in Groups I-VI, classified in class 544, and various subclasses depending on the nature of the substituents.

VIII-XIV. Use of a compound or composition of the general formula (I') according to Claims 14-25, wherein the compound or composition is from Group I-VII respectively, classified in class 514, and various subclasses depending on the nature of the substituents.

2. The inventions are distinct, each from the other because of the following reasons:

2a. In the instant case Groups I-VII are directed to structurally dissimilar compounds such that the variable core created by varying the definitions of the formula do not belong to a recognized class of chemical compounds in the art, and references that exist in anticipating one invention would not render obvious the others. For example, a nitrogen substituted phenyl ring is different than an 7-membered benzoazepine ring. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds

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differ significantly in chemical structures. One skilled in the art would not consider such diverse structures as functional equivalents of each other. The mere fact that there is a single similarity is not in itself a significant reason to render the whole embodiment obvious. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

2b. Groups I-VII and VIII-XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case more than one use exists for the compounds or compositions of Group I-VII as evidenced by claims 21-25, drawn to a variety of diverse uses. Additionally, the various uses would raise issues of enablement separate from that of the compound claims and would require art-recognized evidence that activity relied on its reasonably correlated to in vivo efficacy for the uses claimed.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a non-elected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully

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examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

4. This application contains claims directed to the following patentably distinct species: the various compounds and compositions of the general formula (I'). The species are independent or distinct because they cover a wide range of compounds and compositions that have different core structures as well as not all being disclosed in the current patent application.

In the current application, Groups I-VII are directed to compounds with no common core. Varying the Markush groups will create compounds or compositions that do not belong to a common recognized physical or chemical class. For example, a nitrogen substituted phenyl ring is different than a 7-membered benzoazepine ring. These compounds do not share a common utility, nor do they share a substantial structural feature associated with that utility. Each group's compounds are made and used independently of each other and could support separate patents.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the

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inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023.

The examiner can normally be reached on M-F 7:30-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Cecilia Tsang can be reached at 571-272-0562 or Janet Andres can be reached at 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey H. Murray



**VICKIE KIM
PRIMARY EXAMINER**